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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)																	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed																
		10/660,186	09/11/2003																
		First Named Inventor																	
		Ronald Scott Beckley																	
		Art Unit	Examiner																
		1796	Michael Bernshteyn																
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 51,798</td><td>Carl P. Hemenway</td></tr><tr><td></td><td>Typed or printed name</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>215-619-5242</td></tr><tr><td></td><td>Telephone number</td></tr><tr><td></td><td>August 21, 2009</td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.		<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 51,798	Carl P. Hemenway		Typed or printed name	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	215-619-5242		Telephone number		August 21, 2009		Date
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	Date																		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: : A01477

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/660,186
Applicant : Ronald Scott Beckley
Filed : 9/11/2003
Title : Michael Addition Compositions

Confirmation No. : 5800
TC/Art Unit : 1796
Examiner : Michael Bernshteyn

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-6 and 11-13, 15, 16, and 18-26 are pending in this application. The claims as currently pending were presented in Applicant's paper of July 16, 2009.

Summary of Current Status of Claim Rejections

In the Office Action mailed on May 21, 2009, the Examiner issued a Final Rejection of claims 1-6, 11-13, 15, 16, 18-20, and 22-24 under 35 USC §103(a) as being obvious over US 5,959,028 (Irie) in view of US 2003/0165701 (Straw). In that same Office Action, the Examiner also rejected claims 21 and 25-26 under 35 USC §103(a) as being obvious over Irie in view of Straw and in view of US 6,521,716 (Leake). The Examiner maintained the rejections in an Advisory Action on July 28, 2009.

Summary of Applicants' Argument

Applicants submit that neither Irie nor Straw teach curable mixtures that have the feature of 5% or less by weight non-reactive volatile compounds. Therefore, that feature, which is a feature of all the present claims, is not taught by the combination of Irie and Straw, and therefore the present claims are not obvious over Irie in view of Straw.

The Examiner refers to Leake for teachings regarding lack of base catalyst and regarding anion of Michael donor. Therefore, Applicants submit that there is currently no rejection that points out any teaching in the prior art of the feature of 5% or less by weight non-reactive volatile compounds.

The Teachings of Irie

In the Advisory Action of July 28, 2009, the Examiner stated (Continuation Sheet, second paragraph):

It is noted that the first reference of Irie (U.S. Patent 5,959,028) exemplifies that the curable mixture comprises 5% or less by weight non-reactive volatile compounds (Example 31).

However, in the Office Action of January 09, 2009, the Examiner stated (p. 5, lines 3-4):

Irie does not disclose that the curable mixture comprises 5% or less by weight non-reactive volatile compounds.

Regardless of the Examiner's characterization of Irie, Applicants maintain that Irie does not teach or suggest the feature of 5% or less non-reactive volatile compounds. Applicants have presented detailed analysis of Irie's Example 31, for instance in their paper of July 03, 2007 (from p. 2, final paragraph to p. 3, line 5). Irie's Example 31 discloses a "base coat" that is not a curable mixture in the meaning of the present claims because it has no Michael donor. The only curable mixture disclosed within Irie's Example 31 is the mention of Irie's Example 1, which is a curable mixture and which has 43% by weight non-reactive volatile compounds (205 parts non-reactive volatile compounds out of a total of 472 parts). All of the other curable mixtures disclosed by Irie also have at least 43% non-reactive volatile compounds. In sum, neither Irie's Example 31 nor any other part of Irie's disclosure teaches any curable mixture that has less than 43% by weight non-reactive volatile compounds.

The Teachings of Straw

In the Advisory Action of July 28, 2009, the Examiner stated (continuation sheet, second paragraph):

The second reference of Straw (US Patent Application Publication 2003/0165701) is used ONLY for recitation of common knowledge that coating composition curable by Michael reaction have several advantages.

The all-capital emphasis of "ONLY" is the Examiner's. In that same paragraph, the Examiner stated that "it is not important that the Straw composition itself is water-born." It appears to Applicants that the Examiner is acknowledging that Straw does not teach curable mixtures with 5% or less by weight non-reactive volatile compounds.

Later in the Advisory Action (and in the Office Action of January 09, 2009, page 5, lines 12-13), the Examiner refers to "little or no volatile compounds as taught by Straw." In these statements, the Examiner appears to argue that Straw does teach curable mixtures with 5% or less by weight non-reactive volatile compounds.

Regardless of the Examiner's characterization of Straw, Applicants maintain (as they argued in their papers of July 16, 2009 and April 07, 2009), that Straw teaches compositions that are "water borne" (title, abstract, and paragraph 0013) and that "water borne" means that Straw's composition has much more water than 5% by weight. This argument was supported by the declaration of Dr. Mai Chen of April 07, 2009. Water is a non-reactive volatile compound. Therefore, Straw's composition contains much more than 5% non-reactive volatile compound by weight.

Conclusion

The present claim 1 recites curable mixtures that have the feature that the mixture has 5% or less by weight non-reactive volatile compound. Neither Irie nor Straw discloses a curable mixture that has that feature. Therefore present claim 1 recites a feature that is not disclosed by either Irie or Straw.

Additionally, the Examiner has relied on Leake for Leake's teachings regarding cure "without catalyst" (Final Rejection of May 21, 2009, p. 3, line 11) and regarding the Examiner's assertion that Leake teaches the presence of "anion of Michael donor" (Final Rejection of May 21, 2009, p. 4, line 11). Therefore, the Examiner has not presented any teaching in the prior art of record that teaches the feature of 5% or less non-reactive volatile compounds.

Consequently Applicants submit that present claim 1 is not obvious over Irie in view of Straw and that present claim 1 is therefore allowable, even if the rejections based on Leake are also considered. Because dependent claims 2-6 and 11-13, 15, 16, and 18-26 are directly or indirectly dependent on claim 1, Applicants submit that these dependent claims are allowable for the same reasons.

Therefore, Applicants request that a panel review the review the present application and reverse the present rejections.


Appeal Process

In addition to the arguments presented herein above, Applicants also wish to submit that Applicants' ability to prepare a proper Appeal Brief is hampered by the present circumstances. While Applicants can argue (as they have herein above) why the present claims are not obvious over Irie in view of Straw, Applicants may not be able to properly "address all points made by the examiner" (as required by 37 CFR 41.37 (o)) because some of the points made by the Examiner in the Advisory Action appear to contradict the points made by the Examiner in the preceding two Office Actions.

In sum, Applicants submit that the present rejections of record do not reasonably permit Applicants to prepare a proper Appeal Brief. Therefore, for the additional reason of the unreasonable difficulties associated with preparing an Appeal Brief based on the present rejections of record, Applicants request that a panel review the rejection and allow the present claims.

Respectfully Submitted,

Rohm and Haas Company
Independence Mall West
Philadelphia, PA 19106-2399



Carl P. Hemenway
Agent for Applicants
Registration No. 51,798
Tel: 215-619-5242
Fax: 215-619-1612

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